

## REMARKS

### Claim Objections

Claims 24 and 58 were objected to under 37 C.F.R. 1.75(b) as being duplicate claims.

The Examiner states that Applicant is required to cancel one of the claims or amend the claim(s).

Applicants have cancelled claims 24 and 58, thus making this objection moot.

### Claim Rejections – 35 U.S.C. §112

Claims 23 and 45 remain rejected and claims 6, 28, 29, 46-48, and 53-57 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, for the reasons of record stated in the office action mailed July 29, 2002 under item 11, wherein the Examiner states the term "relative", "very good", "above average", "good", and "particularly suited" are relative terms that have no definite meaning. The terms do not reasonably apprise one of the scope of the invention. It is not clear what type of yield (i.e., grain yield, pollen yield, seed yield, etc.) is referred to by the recitation "very good yield". Moreover, the Examiner states the specification does not teach that the traits in Tables 1-2 can be described in this manner. Further, Table 1, states that there is outstanding resistance for Brown Stem Rot, whereas the claim stated very good resistance to Brown Stem Rot for example. It is not clear if excellent or good resistance to Brown Stem Rot can be considered "outstanding".

Applicants have amended claim 6 and have cancelled claims 23, 45, 28, 29, 46-48, and 53-57, thus alleviating this rejection.

The Examiner states in claims 6 and 28, there is improper antecedent basis for "protoplasts" in line 1 of the claims. It is suggested that the term be removed from the claims,

and that a new claim be introduced directed towards protoplasts produced from a tissue culture from claims 5 or 27.

Applicants have amended claim 5 to provide proper antecedent basis to claim 6 and have cancelled claim 28 thus alleviating this rejection.

The Examiner states in claims 23, 45, 55, and 56, the recitation "derived at least 50% of its alleles" in claims 23 and 45, "deriving 50% of the alleles" in claim 55, and "deriving at least about 50% of its alleles" in claim 56 renders the claims indefinite. The Examiner states it is not clear what is meant by "derived" and "deriving". The Examiner questions have the alleles been transformed into the claimed plants, did the claimed plants inherit the alleles, etc.?

Applicants have cancelled claims 23, 45, 55, and 56 thus alleviating this rejection.

In claim 29, the Examiner states the claim recites the recitation "the tissue culture of claim 24". There is insufficient antecedent basis for this limitation in the claim or claim 24.

Applicants have cancelled claim 29 thus alleviating this rejection.

In claim 46, the Examiner states the claim is indefinite because the recitation "comprising" in line 1 does not clearly indicate how many crosses are to be performed by the method. The Examiner suggests that the recitation --F1 hybrid-- be inserted in claim 46, lines 1 and 6, after "93B87-derived".

Applicants have cancelled claim 46 thus alleviating this rejection.

The Examiner states in claim 57, the recitation "further comprising applying double haploid methods" in lines 1-2 renders the claim indefinite. The recitation broadens the scope of parent claim 53, which only involves crosses and does not encompass any double haploid method. It is also not clear what double haploid method is referring to.

Applicants have cancelled claim 57, thus alleviating this rejection.

The Examiner states in claim 53, the term "comprises" in part (a) of the claim renders it indefinite. It is not clear what obtaining a seed that "comprises" a plant means.

Applicants have cancelled claim 53, thus alleviating this rejection.

Claims 10, 12, 15-23, 32, 34, 37-45, and 47-49 remain rejected to and claims 8, 9, 30, 31, 46, and 50-57 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time that the application was filed, had possession of the claimed invention, for the reasons for record stated in the Office Action mailed July 29, 2002 under item 12 which refers to the Office Action of December 19, 2001 wherein the Examiner states in part, the specification does not describe any of the plants derived from the breeding programs, or all tissue cultures derived from plants parts of soybean variety 93B87. It is well known that chromosome aberrations can be a side effect of tissue culture techniques, which would introduce new characteristics into the tissue culture and in plants regenerated therefrom. The specification does not describe the characteristics of such cultures and plants. In addition, the Examiner states the specification also does not describe the plants that can be produced by the soybean breeding programs, or by crosses wherein one ancestor is soybean variety 93B87 or a plant having all the physiological and morphological characteristics of soybean variety 93B87, wherein the claimed plant is separated from the parent by multiple generations. The description of 93B87 is not indicative of the description of the plants produced by the breeding programs or crosses, as other soybean plants, of unknown genotypes and phenotypes, would be crossed with 93B87 and its progeny. Additionally, to indicate that a plant expresses two 93B87 traits is not a sufficient description of the plant. As numerous plants express traits that are also expressed by 93B87, it is possible that the claimed plant inherited the genes governing those traits from one

ancestor other than 93B87. Further information concerning the genotype of 93B87 may distinguish the claimed plants from others expressing at least two 93B87 traits. Such information would indicate that the genetic information governing the expression of the traits had to be derived from 93B87. However, the specification does not provide any description of the genes, molecular markers, etc. of 93B87.

Presently the Examiner states that the methods of making a product do not describe the morphological and physiological traits of the product itself. Further, the claimed tissue cultures are not subject to this rejection. Moreover, the Examiner states, the specification does not describe any of the alleles of 93B87, and does not describe which of the alleles of any of the claimed progeny plants were inherited from 93B87. The specification does not correlate any function with any of the alleles of 93B87. The specification does not describe the alleles that govern the expression of any of the traits listed in the claims as the alleles of 93B87 are not described, neither are the alleles of its descendants. Further, as plant 93B87 is crossed with other plants to produce the claimed progeny plants, the progeny plants will not possess all of the unique germplasm that forms 93B87. Furtherstill, the claimed plants will also inherit 50% of its alleles from the other parent, and no description is provided at all concerning any of their morphological and physiological traits.

The morphological and physiological description of 93B87 does not provide any information concerning all of the morphological and physiological description of hybrid progeny of 93B87. Further, the specification does not describe any double haploids methods.

Applicants have amended claims 8 and 9 and cancelled claims 10, 12, 15-23, 32, 34, 37-45, and 47-49. Additionally Applicants have cancelled claims 30, 31, and 46 and 50-57, thus alleviating this rejection.

**Claim Rejections – 35 U.S.C. §102 and/or §103**

Claims 10, 17, 21, 22, 32, 40, 44, 49, 50, and 52 remain rejected under 35 U.S.C. §102 (e) as anticipated by or, in the alternative under 35 U.S.C. §103 (a) as being obvious over Steiger et al. (U.S. Patent No. 6,153,816) for the reasons of record stated in the Office Action mailed July 29, 2002 under item 14.

Applicants have cancelled claims 10, 17, 21, 22, 32, 40, 44, 49, 50, and 52, thus alleviating this rejection.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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